APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,462	01/29/2001	John A. Kriho	014530/0320	8030

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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _29 January 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-39_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-39_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _2_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: the application filed on 1/29/01, and

the IDS filed on 11/13/02.

2.   Claims 1-39 are pending in the case. Claims 1, 10, 14, 23, 27, 36 are

independent claims.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-9, 14-22, 27-35 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

Regarding independent claim 1, the limitation "receiving a file from the remote computer

via a network having a document with the *identified data item placed on each of the one*

or more fields" shows that the identified data item *is already filled in the one or more*

fields. It is unclear why claim 2, which is dependent on claim 1, repeats that feature

when stating that "populating the one or ore fields of the document with the identified

data items."

Regarding claim 6, which is dependent on claim 2, populating the one or more fields

with the identified data items indicates that the designed document and the linked data

item are *already in a single file after populating the template with data*. Thus, it is

unclear why bundling the designed document and the linked data items into a single file

is needed.

Independent claims 14 and 27 are rejected under the same issue as in independent

claim 1.

Dependent claims 2-9, 15-22, 28-35 are rejected for fully incorporating the deficiencies

of their base claims 1, 14, 27 respectively.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 1-5, 7-17, 19-30, 32-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bernardo et al. (US Pat No. 6,684,369 B1, 1/27/04, filed 6/19/98) in

view of Nazem et al. (US Pat No. 5,983,227, 11/9/99, filed 6/12/97).

Regarding independent claim 1, Bernardo discloses:

-    designing a document having one or more fields (col 2, lines 38-60: templates

     are designed having one or more fields for creating a web page where a *template*

     is considered as a document with fields for entering data)

-    selecting the document from a list of documents (col 2, lines 49-60: selecting a

     template from a library of templates for populating data; col 3, lines 39-57; col 7,

     lines 49-62)

-    identifying one data item from the one or more data item to place in each of the

     one or more fields in the document based on which of the one or more data items

     are linked to each of the one or more fields in the document (col 2, lines 49-65:

     supplying proper data for populating based on the selected template; col 3, lines

     39-57; col 7, lines 49-62; col 8, lines 1-8)

-    receiving a file from the remote computer via the network having the document

     with the identified data item placed on each of the one or more fields (col 3, lines

     18-28: routing the template with populated fields of the proposed content of a

     web site, which is considered as a document, over the network to the content

     approver terminal suggests receiving said document from a remote computer via

     a network)

Bernardo does not disclose:

- linking one or more data items to each of the one or more fields in the document design

- transmitting the document and the one or more data items over a network to a remote computer

- logging onto the remote computer over the network

Instead, Bernardo discloses:

- the tool for creating a web site, which includes a library of templates installed on a server connected to various client terminals where templates are sent to client terminal by the tool at server upon a client request (col 6, lines 23-31 and figure 2)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have to have modified Bernardo to include transmitting the document template and the data items over the network since the fact that there is a connection between a server and client terminal for sending document templates suggests transmitting the document template over a network to a client terminal, which is the remote computer. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Bernardo to include logging onto the remote computer over the network since it was well known that user has to log into a computer to start using it.

Nazem discloses providing *the templates* to users and allowing users to access to a

large region of shared memory which contains *all of the live data needed to fill any user

template* (col 1, line 60 to col 2, line 15).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Nazem into Bernardo since Nazem discloses the user

preference templates and the live data to fill the templates. This suggests linking data

to the fields in the document design since *the live data used to fill the templates is

related to the template*, and the document design is equivalent to the template where it

was well known in the art that each template has one or more fields to populate data in.

Regarding claim 2, which is dependent on claim 1, Bernardo discloses populating the

one or more fields of the document with the identified data items (figure 3, col 8, lines 1-

12).

Regarding claim 3, which is dependent on claim 2, Bernardo discloses previewing the

document with the identified data items populating the one or more fields before

receiving the file (col 4, lines 5-24: previewing the proposed content, which is the

document template with populated data in the template fields; col 12, lines 26-36:

previewing the web site during creating process).

Regarding claim 4, which is dependent on claim 3, Bernardo discloses modifying the

design of the document or the identified data items after previewing the document.(col

4, lines 5-24 and col 8, lines 10-15: editing the proposed content of the web site

document after reviewing by the content approvers; col 13, lines 1-10 and col 14, lines

1-5: modifying the template, which is the design of the document).

Regarding claim 6, which is dependent on claim 2, Bernardo discloses:

- locating the designed document and the linked data items (col 2, lines 49-65:

  selecting the document template, which is considered as a design of the

  document, from the template library, and supplying data for said template

  inherently show the location of the template to make the selection and the

  location of the data to supply for populating)

- bundling the designed document and the linked data items into a single file (col

  3, lines 18-28: when being routed over the network, the proposed content of the

  web site is a single file of the template with the populated fields)

- wherein the step of transmitting includes transmitting a single file (col 3, lines 18-

  28: it was obvious that electronically routing the proposed content is equivalent to

  transmitting a single file of the proposed content)

Regarding claim 7, which is dependent on claim 1, Bernardo does not disclose

preparing a mailing list, the mailing list including address information linked to at least

one of the one or more fields of the document.

Instead, Bernardo provides the Site Areas including a list of options for web creators to

select for creating a web site such as Company Form Area, Customer Tracking Area,

etc. (figure 5 and col 8, lines 38-47). Bernardo further discloses that based on the

selected option, the view displays the option with input fields for basic information about

company or business (figure 6, col 8, lines 38-47, col 6, lines 39-46) where the basic

information prepared about company includes company name, user name, address, etc.

(figure 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have to have modified Bernardo to include preparing a mailing list

including address information linked to at least one of the one or more fields of the

document for the following reason. Bernardo discloses the Customer Tracking Area

option in the Site Areas and the basic information about a company comprising the

company name and the address. This motivates to prepare a list of customers for

tracking with basic customer information such as customer name and customer

address. This also motivates to use the customer list including address information

linked to at least one or more fields of the document as a mailing list for contacting

customers.

Regarding claim 8, which is dependent on claim 7, Bernardo discloses:

- the mailing list includes a predetermined number of pairs of name and address

  information (as mentioned in claim 7, Bernardo suggests a list of names and

  addresses of customers in the customer tracking list)

- populating the at least one of the one or more fields of the document with each of

  the predetermined number of pairs of name and address information (figure 6:

populating the one or more fields of the document with the predetermined pairs

of name and address information)

Regarding claim 9, which is dependent on claim 8, Bernardo does not disclose that the

received file includes a number of versions of the document corresponding to the

predetermined number of pairs, each version of the document including a respective

one of the predetermined number of pairs.

However, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have to have modified Bernardo to include a number of versions

of the document corresponding to the predetermined pairs of names and addresses for

the following reason. Sine each customer has a specific name and address, it was

obvious various pairs of name and address associated with the document would create

various versions of document due to the different names and addresses.

Regarding independent claim 10, Bernardo discloses:

- receiving a document design and a plurality of data items over a network

  connection, the document design having one or more fields, each of the one or

  more fields linked to at least one of the plurality of data items (figure 2 and col 2,

  lines 49-60: the document template having one or more fields to populate data

  received over a network (sent from server to client terminal) is considered

  equivalent to a document design since the template defines the format or the

  design of a document)

-   generating the printable document based on the document design and the

    populated fields (col 3, lines 54-57: based on the identified template and supplied

    data, the tool generates the customized web site without writing HTML code)

Bernardo does not explicitly disclose:

-   determining which data items are linked to each of the one or more fields in the

    document design

-   receiving a selection of which data item to include in each of the one or more

    fields in the document design

Nazem discloses providing the live data to fill the templates (col 1, line 60 to col 2,

line14). It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have combined Nazem into Bernardo for the following reason.

The fact that Nazem discloses the live data to fill template suggests determining data

linked to the fields of the template via a user selection for data to be populated. Nazem,

thus, provides the advantage to provide to users a plurality of ready data items to fill the

template instead of supplying data by users for filling the template as in Bernardo, which

is time consuming.

Regarding claim 11, which is dependent on claim 10, Bernardo discloses creating a

form for the document design based on the one or more fields, each form having an

entry for each of the one or more fields (col 2, lines 49-60: library of pre-stored

templates, each includes one or more fields inherently shows creating the document

templates, which are considered equivalent to the document design).

Regarding claim 12, which is dependent on claim 11, Bernardo does not disclose

displaying a list of the at least one of the plurality of data items for each entry in the

form.

Nazem discloses the live data to fill the templates (col 1, line 60 to col 2, line14).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Nazem into Bernardo since Nazem discloses the live data

to fill the template thus suggests that the provided live data be organized as a list for

users to select for filling in the fields of the templates.

Regarding claim 13, which is dependent on claim 12, Bernardo does not explicitly

disclose receiving an indication of which data item from the list to provide in each entry

in the form wherein the printable document is generated based on the indication.

Nazem discloses providing the live data to fill the templates (col 1, line 60 to col 2, line

14).   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have combined Nazem into Bernardo for the following reason.

The fact that Nazem discloses the live data to fill template suggests that every time a

user selects a data item to fill the template, the system receive an indication of a data

selection for a field.   And, it was obvious that by filling one or more fields of data in the

template, a document is generated.   Nazem, thus, provides the advantage to provide to

users a plurality of ready data items to select to fill the template instead of user

supplying the data for filling the template as in Bernardo, which is time consuming.

Further, it was well known that any document generated from filling data in a template is in a printable format.

Claims 14-17, 19-26 are for a computer readable medium of method claims 1-5, 7-13, and are rejected under the same rationale.

Claims 27-30, 32-39 are for a system of method claims 1-5, 7-13, and are rejected under the same rationale.

8.   Claims 5, 18, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardo and Nazem as applied in claims 1, 14, and 27 above and further in view of Moore et al. (US Pat No. 6,330,575 B1, 12/11/01, filed 3/31/98).

Regarding claim 5, which is dependent on claim 2, Bernardo does not disclose adjusting the size of each of the identified data items based on the size of the one or more fields to which the identified items are linked.

Moore discloses that the size of the image to be populated into the header field can be adjusted by selecting an option in the image size field, for example, Large (figure 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have to have combined Moore into Bernardo since Bernardo discloses adjusting the data size of the identified items based on the size of the field to which the item is populated providing the advantage to apply to populating data in

Bernardo to solve the problem of the case when the size of the data to be populated

conflicts with the size of the data field.

Claims 18 and 31 are for the computer readable medium and the system of method

claim 5, and are rejected under the same rationale.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Raisleger (US Pat No. 4,645,916, 2/24/87).

Pinard et al. (US Pat No. 5,940,834, 8/17/99, filed 3/13/97).

Gardner (US Pat No. 6,058,391, 5/2/00, filed 12/17/97).

Lombardo et al. (US Pat No. 6,341,290 B1, 1/22/02, filed 5/28/99).

Young et al. (US Pat No. 5,778,049, 7/7/98, filed 6/26/96).

Volino (US Pat No. 6,400,845 B1, 6/4/02, filed 4/23/99).

Barker et al. (US Pat No. 6,141,659, 10/31/00, filed 5/12/98).

Yankovich et al. (US Pat No. 6,704,906 B1, 3/9/04, filed 3/27/99).

Lewis et al. (US Pat No. 6,233,565 B1, 5/15/01, filed 2/13/98).

Ferris et al. (US Pat No. 5,937,418, 8/10/99, filed 7/1/97).

Chen et al. (US Pat No. 6,507,856 B1, 1/14/03, filed 1/5/99).

Brandt et al. (US Pat No. 6,108,673, 8/22/00, filed 2/25/97).

Kunzinger et al. (US Pat No. 6,405,222 B1, 6/11/02, filed 12/17/98).

Salas et al. (US Pat No. 6,230,185 B1, 5/8/01, filed 7/15/98).

Cayton, *Build your own Internet site*, Accounting Technology, Oct 1996, Vol. 12, pg. 41,

5 pgs.

McCracken et al., *Office 2000 : Worth the Bother?*, PC World Online, Mar 8 1999, pg. 1.

Sommer et al., *WebCon: design and modeling of database driven Hypertext Application*,
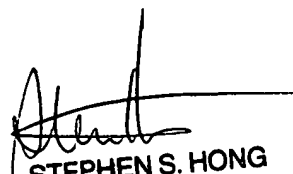
IEEE Jan 1999, pages 1-8.

Challenger et al., *A publishing system for efficiently creating dynamic web content*, IEEE

2000, pages 844-853.

10. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-

0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Clh
3/12/04

STEPHEN S. HONG
PRIMARY EXAMINER